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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/886,388 07/01/97 . SANDHU

G MI22-713

EXAMINER
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021567 MMC2/0227  
WELLS ST JOHN ROBERTS GREGORY AND MATKIN  
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CRANE, S	
ART UNIT	PAPER NUMBER

2811  
DATE MAILED:

02/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

08/886,388

Applicant(s)

SANDHU ET AL.

Examiner

Sara W. Crane

Art Unit

2811

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44, 45, 51-54, 56, 58-60, 62 and 66-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 44, 45, 51-54, 56, 58-60, 62, 66-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

Claims 44-45, 51-54, 56, 58-60, 62, and 66-68 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

See reasons of record in the Office action of 3/15/00.

Claims 44-45, 51-54, 56, 58-60, 62, and 66-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See reasons of record in the Office action of 3/15/00.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 44, insofar as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Morihara et al. in view of Wolf et al.

See reasons of record in the Office action of 3/15/00.

Claims 44-45, 51-54, 56, 58-60, 62, and 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Morihara et al. and Wolf.

See reasons of record in the Office action of 3/15/00.

### ***Conclusion***

Applicant's arguments of 04 December 2000 have been considered, but are not convincing. Each of the issues raised has been treated at length in the record; see, i.e. the Conclusion section of the Office action of 8/29/00. Applicant argues that the claims are enabled as of the filing date, because examples meeting the claim limitations have been disclosed. As noted previously, the issue here is *scope of enablement*. That is, Applicant seeks patent coverage for devices made "using a photolithographic process having a characteristic minimum photolithographic feature dimension." Examiner interprets Applicant's remarks of 12/21/99 to mean that the scope of coverage sought by the Applicant is such as to encompass devices made using photolithographic processes having feature dimensions that cannot be made by currently known photolithographic processes. If Applicant believes that the claim language is not intended to encompass processes not known at the time of the invention, Applicant should state this clearly on the record. Examiner agrees that all photolithographic processes have an associated minimum feature size. The issue is not whether these terms are known in the art. The issue, to state it once again and as clearly as possible, is: What is the scope of coverage sought by the Applicant? It appears to the examiner that the scope of coverage sought is such as to encompass feature sizes, and photolithographic processes, not currently known. The scope of coverage sought is thus not commensurate with the teachings of the specification. Applicant states, "Applicants are not claiming a lithographic process." Applicant has presented claims in product-by-process form, with a process step specifically recited in each independent

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claim. Of course, the claims are claiming the subject matter recited in the claims. The problem is simply that the scope of coverage sought is such as to encompass feature sizes, and photolithographic processes, not currently known. Applicant argues that there would be no reasonable expectation of success were one to make the known devices of the prior art according to the known lithographic processes taught in the Wolf textbook. The difference between "photolithographic processes" and the Wolf processes are simply that the Wolf processes allow for smaller dimensions to be formed. Wolf is a *textbook*, teaching what is supposedly well known to all in the art. One of ordinary skill would presume that textbook teachings are not hypothetical, and can be successfully used to make devices. There is every reason to expect success in the routine application of a textbook teaching.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

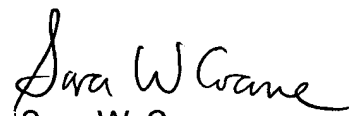
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Crane, whose telephone number is (703) 308-4894.

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The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0956.

A handwritten signature in black ink, reading "Sara W. Crane". The signature is fluid and cursive, with the first letters of each word being capitalized and prominent.

Sara W. Crane  
Primary Examiner  
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